

REMARKS

The Official Action of 21 August 2007 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The indication that the prior art rejections over Coran et al have been withdrawn has been noted with appreciation. The re-application of rejections based on Otawa et al has also been noted as well as the explanation that the rejections have been re-applied because the amendment that previously overcame the rejection based on Otawa et al was later removed. See Official Action at paragraph 1. Applicants have now re-introduced into the independent claims the amendment that previously overcame the Otawa et al rejection. Specifically, Applicants have incorporated into claims 1, 9, and 30 the recitations previously in claims 26 and 29 (now canceled), which limit the rubber in the rubber phase of the claimed elastomer to a Markush group that does not include the rubber described in the reference (see discussion below).

Claim 9 has also been amended with the incorporation of the recitations formerly in claim 12 (now canceled). This amendment respectfully removes the bases for the rejections under 35 USC 112, first and second paragraphs, appearing at paragraph 5 and paragraph 7 respectively of the Official Action. Applicants respectfully note that these rejections were not applied against the subject matter of claim 12, which has now been incorporated into claim 9.

Certain claims were rejected under 35 USC 102(b) as allegedly being anticipated by

Otawa et al (paragraph 9 of the Official Action), and other claims were rejected under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being obvious over Otawa et al (paragraph 11 of the Official Action). Applicants respectfully traverse these rejections.

As discussed above, all claims as amended limit the rubber in the rubber phase of the claimed elastomer to a Markush group that does not include the rubber taught by the reference. As discussed in the response filed on August 5, 2005, Otawa et al disclose a fine particulate cross-linked amorphous ethylene/α-olefin/propylene copolymer, and said fine particulate cross-linked rubber is prepared by the specifically described method. Otawa et al do not show or suggest a rubber from the claimed Markush group. Moreover, Otawa et al make clear that the ethylene/alpha-olefin copolymer is critical to the invention described therein (see, e.g., Abstract and claim 1) such that there could not have been any motivation or reason in the prior art to substitute a different polymer. See MPEP 2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”). Accordingly, Applicants respectfully submit that the amendments to the claims remove the bases for the rejections.

The claims stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over the combined limitations of claims 1-6 and 18 of US Patent 6,838,490. Applicants respectfully traverse this rejection.

The Examiner has acknowledged that the claims of the '490 patent do not show the claimed weight ratio of rubber phase to plastic matrix, but has cited MPEP 2144.05 for the proposition that this ratio would have been obvious because it is a result effective variable. However, as discussed in MPEP 2144.05(II)(B), only variables which the prior art **recognizes** to be result effective variables can be optimized. ("A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.") The Examiner has respectfully not pointed to anything in the claims of the '490 patent to show any such recognition and, accordingly, has respectfully not established even a *prima facie* case of obviousness of the claimed invention over the claims of the '490 patent. Accordingly, Applicants respectfully submit that the rejection should be withdrawn.

The claims stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over the combined limitations of claims 1-16 of US Patent 6,998,438. Applicants respectfully traverse this rejection.

The Examiner has acknowledged that the claims of the '438 patent do not show the claimed *spheroidic* rubber phase, but contends that this would have been inherently present due to the irradiation-vulcanization of latex. However, the **claims** of the '438 patent do not recite irradiation-vulcanization of latex. Moreover, when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the

claim of a patent, the disclosure of the patent may not be used as prior art. See MPEP 804. Accordingly, there is respectfully insufficient basis for the double patent rejection and Applicants respectfully submit that it should be withdrawn.

The claims stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over the combined limitations of claims 1-6, 22 and 23 of US Patent 6,423,760. Applicants respectfully traverse this rejection.

The Examiner has acknowledged that the claims of the '760 patent do not show the claimed weight ratio of rubber phase to plastic matrix, but has cited MPEP 2144.05 for the proposition that this ratio would have been obvious because it is a result effective variable. However, as discussed in MPEP 2144.05(II)(B), only variables which the prior art **recognizes** to be result effective variables can be optimized. ("A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.") The Examiner has respectfully not pointed to anything in the claims of the '760 patent to show any such recognition and, accordingly, has respectfully not established even a *prima facie* case of obviousness of the claimed invention over the claims of the '760 patent. Accordingly, Applicants respectfully submit that the rejection should be withdrawn.

In view of the above, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

CLIFFORD J. MASS
LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890